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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,335	07/03/2003	Walter A. Zohmann	10012.7	5090
21999	7590	11/24/2010	EXAMINER	
KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			CAMPBELL, VICTORIA P	
			ART UNIT	PAPER NUMBER
			3763	
			MAIL DATE	DELIVERY MODE
			11/24/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/613,335

Applicant(s)

ZOHMANN, WALTER A.

Examiner

VICTORIA P. CAMPBELL

Art Unit

3763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763

Continuation of 3. NOTE: the new limitation of claim 1 has not been previously considered in combination with the limitations of the current device claim, and as such requires further consideration.

Continuation of 11. does NOT place the application in condition for allowance because: the arguments presented on November 3, 2010 fail to overcome the rejections made in the Final Rejection dated August 3, 2010. Regarding applicant's amendment to overcome the rejections under 35 U.S.C. 112 first paragraph, the examiner notes that the amendments to claims 1, 5, and 7 appear sufficient. However, claims 10-12 are still unsupported in the specification as filed. Regarding the rejection of claims 1-12 under 35 U.S.C. 112 first paragraph with regard to enablement of the limitation "structured to allow location of all fenestrations within a fascial compartment during injection", the examiner notes that none of the cited passages appear to provide support for this limitation, they merely provide support for avoiding intravascular injection, or avoiding penetration of the effected nerve: neither of which is tantamount to located the fenestrations ONLY within the fascial compartment. Further, regarding applicant's argument that the prior art of record (Smith et al in view of Sorenson et al) fails to disclose the limitations of the claims 1, 2, and 7-9, the examiner disagrees. While the Smith et al and Sorenson et al references may be directed to differing intended uses, their use in different procedures does not preclude them from use in injecting anesthetic to a fascial compartment. Furthermore, the examiner notes that both Smith et al and Sorenson et al are both catheters used in various injection procedures, and one having ordinary skill in the art would look to their teachings when designing a catheter for an injection procedure, regardless of its location. Regarding applicant's arguments regarding the size and spacing of the apertures of Sorenson et al, the examiner notes that the drawings of Sorenson et al are not indicated as drawn to scale and therefore can not be relied upon to teach a distance between the apertures. Furthermore, a teaching of a preferred diameter aperture (or spacing of the apertures relative to one another, were such a teaching present) does not render a different diameter (or spacing) non-obvious. Regarding applicant's argument that the prior art does not teach use in the fascial compartment and therefore does not teach the method of claim 7, the examiner disagrees and notes that it would have been obvious to use the devices and injection methods known and used in any other portion of the body for injection into the fascial compartment, and as such, the method of claim 7 would have been obvious to one having ordinary skill in the art.